

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed November 14, 2006 rejected claims 1-19. This is a full and timely response to that outstanding Office Action. Upon entry of the amendments in this response, claims 1-19 are pending. More specifically, claims 1, 2, 3, and 13 are amended. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 1 and 13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 13 of copending application number 10/602,986. Claims 1-19 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by *Wasilewski* (U.S. Patent No. 5,418,782). The rejections under 35 U.S.C. 102(b) are respectfully traversed where not rendered moot by amendment.

II. Rejections Under 35 U.S.C. §102(b)**A. Claims 1-12**

The Office Action rejects claims 1-12 under 35 U.S.C. 102(b) as allegedly being anticipated by *Wasilewski* (U.S. Patent No. 5,418,782). For at least the reasons set forth below, Applicant respectfully traverses the rejection where not rendered moot by amendment.

Independent claim 1, as amended, recites:

1. A method for providing a plurality of programs in a conditional access system, the method comprising the steps of:

using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream;

encrypting the selected portion of each of the plurality of digital bit streams; combining the encrypted portion and the unencrypted portion with the transport stream; and

transmitting the combined stream.

(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that the amendments to claim 1 have rendered the rejection moot. Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that *Wasilewski* does not disclose, teach, or suggest at least **using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream**. Even if, assuming for the sake of argument, *Wasilewski* discloses that each type of stream is uniquely assigned a packet ID, *Wasilewski* fails to disclose using that packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream. *Wasilewski* fails to disclose how the packets are selected for encryption. If the Office Action is inferring that *Wasilewski* inherently uses the PID to select which packets are encrypted, Applicant respectfully submits that “[a]nticipation by inherency requires that 1) the missing descriptive matter be 'necessarily present' in the prior art reference

..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). In *Wasilewski*, the system could use some other method for selecting which packet to encrypt. For instance, any packet following an audio packet could be selected for encryption. Alternatively, every fourth packet could be selected for encryption. Therefore, it is not necessary to, nor inherent to use a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport stream. Thus, *Wasilewski* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1, as amended, is allowable over the cited references of record, dependent claims 2-12 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-12 contain all the features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-12 are patentable over *Wasilewski*, the rejection of claims 2-12 should be withdrawn and the claims allowed.

B. Claims 13-19

The Office Action rejects claims 13-19 under 35 U.S.C. 102(b) as allegedly being anticipated by *Wasilewski* (U.S. Patent No. 5,418,782). For at least the reasons set forth below, Applicant respectfully traverses the rejection where not rendered moot by amendment.

Independent claim 13, as amended, recites:

13. A method for providing a plurality of programs in a conditional access system, the method comprising the steps of:

using an identifier to select for encryption a portion of a plurality of elementary bit streams from a plurality of programs;
encrypting the selected portion of the streams;
combining the encrypted portion and the remaining portion of the selected streams with the plurality of programs to provide a partially-encrypted stream; and
transmitting the partially-encrypted stream.

(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that the amendments to claim 1 have rendered the rejection moot. Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that *Wasilewski* does not disclose, teach, or suggest at least ***using an identifier to select for encryption a portion of a plurality of elementary bit streams from a plurality of programs.*** Even if, assuming for the sake of argument, *Wasilewski* discloses that each type of stream is uniquely assigned a packet ID, *Wasilewski* fails to disclose using that identifier to select for encryption a portion of a plurality of elementary bit streams from a plurality of programs. *Wasilewski* fails to disclose how the packets are selected for encryption. If the Office Action is inferring that *Wasilewski* inherently uses the PID to select which packets are encrypted, Applicant respectfully submits that “[a]nticipation by inherency requires that 1) the missing descriptive matter be 'necessarily present' in the prior art reference ...” *Continental Can*

Co. v. Monsanto Co., 948 F.2d 1264 (Fed. Cir. 1991). In *Wasilewski*, the system could use some other method for selecting which packet to encrypt. For instance, any packet following an audio packet could be selected for encryption. Alternatively, every fourth packet could be selected for encryption. Therefore, it is not necessary to, nor inherent to use an identifier to select for encryption a portion of a plurality of elementary bit streams from a plurality of programs. Thus, *Wasilewski* does not anticipate independent claim 13, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 13, as amended, is allowable over the cited references of record, dependent claims 14-19 (which depend from independent claim 13) are allowable as a matter of law for at least the reason that dependent claims 14-19 contain all the features of independent claim 13. Therefore, since dependent claims 14-19 are patentable over *Wasilewski*, the rejection of claims 14-19 should be withdrawn and the claims allowed.

III. Miscellaneous Issues

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-19 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

/BAB/
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